

REMARKS

Applicants have carefully reviewed the Office Action dated September 14, 2006. Claims 1-40, 52-55, 57, 58, 64-67, 69, 70, 76 and 77 were pending in the application, of which claims 2-16, 18, 23-38, 40, 53-55, 58, 65-67, 70, 76 and 77 were previously withdrawn from consideration. Claims 41-51, 56, 59-63 and 68 were previously cancelled. Claims 1, 17, 19-22, 39, 52, 57, 64 and 69 have been rejected in the current Office Action. Claims 1, 20, 52 and 64 have been amended and claims 78 and 79 have been added with this Response.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 17, 19-21, 39, 52, 57, 64 and 69 were rejected under 35 U.S.C. §102(e) as being anticipated by Slater, U.S. Patent No. 6,623,448. Applicants respectfully traverse this rejection. In order for a reference to anticipate a claim, each and every element of the claim must be present in the reference. See M.P.E.P. §2131.

Slater discloses a steerable drug delivery device. As shown in Figures 2-3B, the distal tip of the device apparently has a needle tip 26 extending out of the end of the catheter assembly distal end 20. In the Office Action, it was stated “that the formation of the needle tip constitutes an elongated axial cut out through a tubular wall to form a stinger, i.e. the needle tip – considered a non-tubular stinger because the needle tip lacks a lumen, with the remaining portion of the tubular wall.” See paragraph 7 of the Office Action. Applicants respectfully disagree with this characterization of Slater. At column 5, lines 44-50, Slater states:

Needle 26 includes a tissue-piercing tip 54 having a dispensing port 55. Dispensing port 55 is in fluid communication with a central lumen 56 of needle 26. Central lumen 56 of needle 26 extends through needle 26 to be in fluid communication with the inner lumen of inner member 24, which couples dispensing port 55 with a source of the therapeutic substance.

In other words, in order for fluids to travel through the needle 26, the fluids would apparently have to travel down the needle central lumen 56 and through the dispensing port 55. In other words, there is apparently a lumen that extends the entire length of the needle 26, and this lumen consists of the central lumen 56 and the dispensing port 55. As such, Applicants respectfully assert that this needle 26 is not a non-tubular structure as asserted in the Office Action. Because at least the non-tubular stinger that is required by each of claims 1, 20, 52 and 64 is missing from Slater, this reference cannot anticipate these claims.

Applicants also point out that Slater does not appear to have a distal tubular member, a proximal hypotube and a balloon, as recited in claim 20. As such, this claim is allowable over this reference for this additional reason. Because they are dependent on claims 1, 20, 52 and 64 and because they contain additional patentably distinct elements, Applicants also assert that claims 17, 19, 21, 39, 57 and 69, and new claims 78 and 79, are allowable over this reference.

Claims 1, 17, 19-21, 39, 52, 57, 64 and 69 were rejected under 35 U.S.C. §102(b) as being anticipated by Krause et al., U.S. Patent No. 5,322,505 (hereinafter "Krause"). Applicants respectfully traverse this rejection. In order for a reference to anticipate a claim, each and every element of the claim must be present in the reference. See M.P.E.P. §2131.

Krause discloses a surgical instrument that can apparently be used for powered atherosclerotic surgery. As shown in Figure 2, it appears that the instrument can have a rigid, stationary, outer tube 12 within which is disposed a rotating inner tube 14. See column 4, lines 26-27. The tubes can apparently be rotated with respect to one another in order to provide a cutting action. The openings (22, 24) of the tubes can provide the actual cutting surfaces. The openings (22, 24) in the tubes (12, 14) are apparently on the side of the distal tip of the tubes (12, 14) in order to facilitate the cutting action of the instrument.

In contrast, claims 1, 52 and 64 all recite, in part, that the inflation lumen has a distal opening that opens in a distal direction. The openings (22, 24) in Krause are on the side of the tubes (12, 14), and appear not to be a distal opening that opens in a distal direction. Because Krause appears to be missing at least this element of claims 1, 52 and

64, these claims are allowable over this reference. Because they are dependent on claims 1, 52 and 64 and because they recite additional patentably distinct elements, Applicants also assert that claims 17, 19, 57 and 69, and new claims 78 and 79, are allowable over this reference.

Further, claim 20 recites, in part, a distal tubular member defining a first lumen and a proximal hypotube. Both of these tubular members have a lumen. These lumens are fluidly connected to form an inflation lumen, and a balloon is fluidly coupled to the inflation lumen. Krause does not disclose such a structure. Because Krause appears to be missing at least this portion of claim 20, Applicants assert that this claim is allowable over this reference. Because they are dependent on claim 20 and because they recite additional patentably distinct elements, Applicants also assert that claims 21 and 39 are allowable over this reference.

Claims 1, 17, 64 and 69 were rejected under 35 U.S.C. §102(b) as being anticipated by Swanson, U.S. Patent No. 5,743,876. Applicants respectfully traverse this rejection. In order for a reference to anticipate a claim, each and every element of the claim must be present in the reference. See M.P.E.P. §2131.

Swanson discloses a catheter having a shaft of varying stiffness. In Figure 9, a fixed-wire catheter is shown that has a proximal single lumen shaft 210. Apparently, a wire 230 is fixedly attached to the inside of the shaft 210 proximal of the distal end of the shaft 210. The wire 230 appears to extend toward the center of the shaft 210, then distally out of the shaft 210, apparently attaching to the distal neck of the balloon 240. See column 6, lines 39-50.

In contrast, claims 1 and 64 both recite, in part, a stinger formed by a distal extension of the tubular wall of the tubular shaft of the hypotube. It appears as though the wire 230 of Figure 9 is being equated with the stinger of claims 1 and 64. Applicants respectfully disagree with this characterization of wire 230. Simply put, a wire that is attached proximal the distal end of a shaft 210 and extends toward the center of the shaft 210 and then distally out of the shaft 210 cannot be called a stinger formed by a distal extension of a tubular wall, as recited in claims 1 and 64. Because at least this portion of claims 1 and 64 are missing from Swanson, Applicants assert that these claims are allowable over these references. Because they are dependent on claims 1 and 64 and

because they contain additional patentably distinct elements, Applicants also assert that claims 17 and 69 are allowable over this reference.

Claim Rejections Under 35 U.S.C. § 103

Claims 19-22, 39, 52 and 57 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Swanson. Applicants respectfully traverse this rejection. In order for a reference to render a claim obvious, each and every element of the claim must be present in the cited prior art. See M.P.E.P. §2143.03.

As mentioned above, Swanson does not appear to disclose a stinger formed by a distal extension of a tubular wall. This structure is recited in both claims 1 and 52. Because Swanson is missing at least this element, Applicants respectfully assert that claim 52 is allowable over this reference. Further, because they are dependent on claims 1 and 52 and because they contain additional patentably distinct elements, Applicants also assert that claims 19 and 57 are allowable.

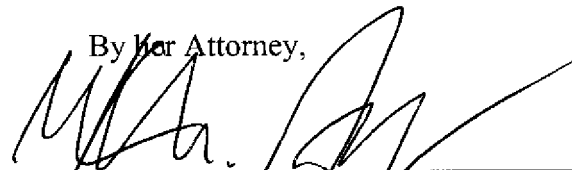
Further, claim 20 recites, among other elements, a proximal hypotube with a stinger, a distal tubular member and a balloon, the stinger extending distally from a distal end of the hypotube and being attached to the distal tubular member. This structure is not disclosed in Swanson. Because Swanson is missing at least this portion of claim 20, Applicants assert that this claim is allowable over this reference. Because they are dependent on claim 20 and because they contain additional patentably distinct elements, Applicants also assert that claims 21, 22 and 39 are allowable over this reference.

CONCLUSION

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance, issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

TRACEE E.J. EIDENSCHINK

By  Attorney,

Date: Dec. 12, 2006

Glenn M. Seager, Reg. No. 36,926
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Tel: (612) 677-9050